

RECEIVED
CENTRAL FAX CENTER**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

NOV 01 2004

In the Patent Application of

Richard E. VOGEL and
Timothy J. FOLTZ.

Group Art Unit: 3727

Serial No.: 09/681,099

Examiner: Merek, Joseph C.

Filed: January 4, 2001

For: CONFECTION CUP ASSEMBLY

SECOND AMENDED APPEAL BRIEFMail Stop Appeal Brief- Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is a Second Amended Appeal Brief filed under 37 C.F.R. §1.192 appealing the decision of the Examiner dated December 15, 2003, and mailed December 23, 2003. Each of the topics required by Rule 192 is presented herewith and is labeled appropriately.

Applicants note that even though new rules for appeal briefs under 37 C.F.R. § 41.37 ("the new rules") took effect on September 13, 2004, the current amended appeal brief can still be filed under the prior rules of 37 C.F.R. §1.192 ("the old rules") since the original appeal brief was filed before September 13, 2004. Support for the applicability of the old rules in this instance is found at paragraph 6 of the *Clarification of the Effective Date Provision in the Rules of Practice before the Board of Patent Appeals and Interferences* published on the USPTO's web site at: <http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/bpai91304.pdf>

Application No: 9/681,099
Page 2 of 27

Attorney Docket: 70254-328

I. REAL PARTY IN INTEREST

Dart Container Corporation having offices in Mason, Michigan ("Dart") is the real party in interest of the present application. An assignment of all rights in the present application to Dart was executed by the inventors and recorded in the U.S. Patent and Trademark Office at reel 011476, frame 0909.

II. RELATED APPEALS AND INTERFERENCES

Appellants filed a Notice of Appeal on October 3, 2002, related to claims 1-17, 19-30, 32, 34-38, 42, 43, 45, 46, 52, and 81, which had been twice rejected pursuant to a final Office Action dated July 3, 2002. Appellants' Brief was submitted on December 3, 2002. A Notice of Non-Compliance was mailed on March 10, 2003, and Appellants submitted a new Appeal Brief on April 2, 2003. In response to Appellants' Brief, in a non-final Office Action dated June 20, 2003, the Examiner withdrew the finality of the July 3, 2002, Office Action and reopened prosecution based solely on a restriction requirement. Appellants then filed a Request for Reinstatement of Appeal on July 16, 2003. In response, on October 6, 2003, the Examiner filed a reply stating that Appellants' Request for Reinstatement of Appeal was improper for not making an election in response to the restriction requirement. On November 6, 2003, Appellants filed a Petition To The Director to invoke the Director's supervisory authority and force the Examiner to either reinstate the appeal or reopen prosecution based on a new substantive ground of rejection. The Examiner subsequently responded with a non-final Office Action mailed December 23, 2003, which again withdrew the finality of the July 3, 2002, Office Action, reopened prosecution, asserted new grounds for rejection of claims 42, 43-46, 52, and 81, and again rejected claims 1-17, 19-30, 32, and 34-38 on the grounds previously asserted. No new grounds of rejection as to claims 1-17, 19-30, 32, and 34-38 were asserted.

III. STATUS OF CLAIMS

Claims 1-17, 19-30, 32, and 34-38, which are presented in the Appendix, are pending in the application and have been thrice rejected by the Examiner on the same grounds. Claims 33, 39-61, and 81 have been cancelled from the application without prejudice solely to place the

Application No: 9/681,099
Page 3 of 27

Attorney Docket: 70254-328

claims in better form for appeal. Claims 18 and 31 are pending in the application and have been objected to by the Examiner. Claims 62-80 have been allowed and are not presented here on appeal. Accordingly, the Appellants hereby appeal the continuing rejection of claims 1-17, 19-30, 32, and 34-38.

IV. STATUS OF AMENDMENTS

Subsequent to the Office Action dated December 23, 2003, an Amendment and Response was filed on February 5, 2004, canceling claims 33, 39-61, and 81 without prejudice, and amending claim 79 to change its dependency from claim 81 to claim 75. The proposed amendment was filed concurrently with the February 5, 2004, appeal brief.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Appellants' invention relates to a confection cup assembly 10 for use in mixing the ingredients of a confection, such as a malt or the like, which can include chunks or particles of ingredients, like chocolate, mixed with the ice cream. The ingredients are placed in a cup and mixed using a mechanical stirrer.

The confection cup assembly comprises a collar 12 having a portion inserted within an open top of a conventional disposable confection cup 14, which is retained within a sleeve 16. The collar 12 and sleeve 16 cooperate to prevent the rotation of the confection cup 14 during the mixing of the confection ingredients. The sleeve 16 adds additional structural rigidity to the confection cup 14 to prevent damage of the cup during the mixing of the confection ingredients, especially from the pressure exerted on the cup walls from the dense and particle-laden confection slurry, and from the impact when the confection cup is struck against a work surface to encourage the confection ingredients to settle. (Application, ¶23.)¹

The collar 12 comprises an insert portion 20 and an extension portion 22 whose junction forms an annular shoulder 24. The insert portion 20 has an outer diameter sized so that it will be

¹ The application giving rise to this appeal was filed using the Patent Office's electronic filing system which does not use page and line numbering. Thus, supporting references are made to paragraph numbers rather than page and line numbers as otherwise required by 37 C.F.R. §1.192(c)(5).

Application No: 9/681,099
Page 4 of 27

Attorney Docket: 70254-328

snugly received within the confection cup 14. (Application, ¶25.) The extension portion 22 extends above the confection cup 14 and terminates in an upper lip 26, which provides the open top of the extension 22 with additional hoop strength and a structure for mounting a lid (not shown), if desired. (Application, ¶26.)

The sleeve 16 comprises a body 40 defining a sleeve recess 45 terminating in an open top defined by an outwardly directed annular lip 42 on one end and a closed bottom formed by a bottom wall 44 on the opposing end. The cross-sectional profile of the body 40 preferably conforms to the cross-sectional profile of the cup 14, so that when the cup is completely received within the sleeve 16, the cup will be in abutting relationship with at least a portion, and preferably over the entire inner surface 41, of the body 40 of the sleeve 16. (Application, ¶29.)

The bottom wall 44 comprises an upper surface 49 that conforms to the base of the cup by providing an annular channel 50 defining and circumscribing a raised platform 52. The annular channel 50 and platform 52 conform to the shape of the confection cup bottom so that the external surface of the confection cup bottom is substantially completely supported by the platform 52. (Application, ¶31.) The bottom wall 44 also includes an opening 54 extending entirely therethrough. The opening enables air to freely enter and exit the sleeve during the insertion and removal of the cup to relieve air pressure and ease the insertion and removal of the cup and ensure that the cup is properly seated against the bottom wall of the sleeve 16. (Application, ¶33.)

The length of the sleeve 16 and the length of the insert portion 20 of the collar 12 are such that a portion of the confection cup 14 is frictionally and/or compressively retained therebetween. Preferably, the length of the sleeve 16 and the length of the collar insert portion 20 are such that the bottom 32 of the collar insert portion 20 extends below the lip 42 of the sleeve 16 to define a collar overlap area 34 and a sleeve overlap area 36 when the collar 12, confection cup 14, and sleeve 16 are assembled. Further, the inner diameter of the sleeve 16 and the outer diameter of the insert portion 20 along the overlap areas 34, 36 are such that they define a gap therebetween that is equal to or less than the thickness of the confection cup 14 along at least a portion of the overlap areas 34, 36 to ensure that at least a portion of the confection cup 14 is compressively retained between the sleeve 16 and the insert portion 20 of the collar 12.

Application No: 9/681,099
Page 5 of 27

Attorney Docket: 70254-328

(Application, ¶34.)

The sleeve can include at least one, but preferably multiple, longitudinal slots 62 extending substantially along the entire length of the body 40, dividing the body into multiple sections 64. The slots 62 permit the inner diameter of the sleeve to be adjusted by the user by merely squeezing the body 40 to press the various body sections 64 into contact with the confection cup 14 to add a compressive force directly to the exterior of the cup and improve any compressive or frictional retention between the overlapping portions of the sleeve and the collar 12 and between the sleeve and the cup alone. (Application, ¶38.) The collar 12 can be provided with a thin layer of frictional material 72, such as rubber, disposed about the periphery of the insert portion 20, preferably along the portion of the insert portion forming part of the overlap area 34, to improve the tendency of the confection cup 14 to remain stationary relative to the collar 12 and the sleeve 16 during the mixing of the confection ingredients. (Application, ¶40.)

The collar 12 can also be provided with a series of bumps, protrusions, or embossments 92 extending outwardly from the exterior surface of the insert portion 20. The bumps 92 abut and depress a portion of the inner surface of the confection cup 14 to retard the tendency of the confection cup 14 to spin relative to the collar 12. The bumps 92 can also be provided on the inner surface 41 of the sleeve 16. (Application, ¶42.) Additionally, the sleeve can be provided with a series of ribs 82 extend inwardly along the inner surface 41 of the body 40. The ribs 82 preferably extend a sufficient distance from the inner surface 41 of the body 40 so that they will abut and depress a portion of the exterior surface of the confection cup 14 when the confection cup is inserted into the sleeve 16. Similar ribs can also be provided on the exterior surface of the insert portion 20 of the collar 12. (Application, ¶41.)

VI. ISSUES

1. Whether the invention of claims 1-12, 19-29, 32, and 34-37 is obvious under 35 U.S.C. §103(a) over Marsters et al. in view of French Patent FR 1,437,341. In the rejection of July 3, 2002, the Examiner rejected claims 1-12, 19-29, 32, and 34-37 as obvious under 35 U.S.C. §103(a) over Marsters et al. in view of French Patent FR 1,437,341. Appellants disagree

Application No: 9/681,099
Page 6 of 27

Attorney Docket: 70254-328

with the Examiner's assertion that the Marsters et al. reference in view of French Patent FR 1,437,341 renders the claimed invention obvious to one skilled in the art.

2. Whether the invention of claims 14-16, 30, and 38 is obvious under 35 U.S.C. §103(a) over Marsters et al. in view of French Patent FR 1,437,341 and further in view of Smith et al. In the rejection of July 3, 2002, the Examiner rejected claims 14-16, 30, and 38 as obvious under 35 U.S.C. §103(a) over Marsters et al. in view of French Patent FR 1,437,341 and further in view of Smith et al. Appellants disagree with the Examiner's assertion that the Marsters et al. reference in view of French Patent FR 1,437,341 and the Smith et al. reference renders the claimed invention obvious to one skilled in the art.

3. Whether the invention of claims 17 and 30 is obvious under 35 U.S.C. §103(a) over Marsters et al. in view of French Patent FR 1,437,341 and Smith et al. and further in view of Fitzgerald et al. In the rejection of July 3, 2002, the Examiner rejected claims 17 and 30 as obvious under 35 U.S.C. §103(a) over Marsters et al. in view of French Patent FR 1,437,341 and Smith et al. and further in view of Fitzgerald et al. Appellants disagree with the Examiner's assertion that the Marsters et al. reference in view of French Patent FR 1,437,341 and the Smith et al. reference, and further in view of the Fitzgerald et al. reference, renders the claimed invention obvious to one skilled in the art.

4. Whether the invention of claims 1-7, 9-13, 19-24, 26-29, 32, and 34-37 is obvious under 35 U.S.C. §103(a) over Marsters et al. in view of Schmiedeknecht (the British Patent). In the rejection of July 3, 2002, the Examiner rejected claims 1-7, 9-13, 19-24, 26-29, 32, and 34-37 as obvious under 35 U.S.C. §103(a) over Marsters et al. in view of Schmiedeknecht. Appellants disagree with the Examiner's assertion that the Marsters et al. reference in view of Schmiedeknecht renders the claimed invention obvious to one skilled in the art.

5. Whether the invention of claims 14-16, 30, and 38 is obvious under 35 U.S.C. §103(a) over Marsters et al. in view of Schmiedeknecht (the British Patent) and further in view of Smith et al. In the rejection of July 3, 2002, the Examiner rejected claims 14-16, 30, and 38 as obvious under 35 U.S.C. §103(a) over Marsters et al. in view of Schmiedeknecht and further in view of Smith et al. Appellants disagree with the Examiner's assertion that the Marsters et al.

Application No: 9/681,099
Page 7 of 27

Attorney Docket: 70254-328

reference in view of the Schmiedeknecht reference and further in view of the Smith et al. reference renders the claimed invention obvious to one skilled in the art.

6. Whether the invention of claims 17 and 30 is obvious under 35 U.S.C. §103(a) over Marsters et al. in view of Schmiedeknecht and Smith et al. and further in view of Fitzgerald et al. In the rejection of July 3, 2002, the Examiner rejected claims 17 and 30 as obvious under 35 U.S.C. §103(a) over Marsters et al. in view of Schmiedeknecht and Smith et al. and further in view of Fitzgerald et al. Appellants disagree with the Examiner's assertion that the Marsters et al. reference in view of the Schmiedeknecht reference and the Smith et al. reference, and further in view of the Fitzgerald et al. reference, renders the claimed invention obvious to one skilled in the art.

VII. GROUPING OF CLAIMS

For the ground of rejection identified in Issue 1, claims 1-8 stand together as a group, claims 9-10 stand together as a group, claims 11-12 stand together as a group, claims 19-25 stand together as a group, claims 26-27 stand together as a group, claims 28, 29, 32, 36, and 37 all stand alone, and claims 34-35 stand together as a group.

For the ground of rejection identified in Issue 2, claims 14-16 stand together as a group, and claims 30 and 38 stand together as a group.

For the ground of rejection identified in Issue 3, claims 17 and 30 stand together as a group.

For the ground of rejection identified in Issue 4, claims 1 and 3-7 all stand together as a group, claims 9 and 10 stand together as a group, claims 11 and 12 stand together as a group, claims 19-24 stand together as a group, claims 26 and 27 stand together as a group, claims 28 and 29 stand together as a group, claims 34, 35, and 37 stand together as a group, and claims 2, 13, 32, and 36 stand alone.

For the ground of rejection identified in Issue 5, claims 14-16, 30, and 38 all stand together as a group.

For the ground of rejection identified in Issue 6, claims 17 and 30 stand together as a group.

Application No: 9/681,099
Page 8 of 27

Attorney Docket: 70254-328

Arguments in support of the patentability of these claims are presented in the following remarks.

VIII. ARGUMENTS

1. WHETHER THE INVENTION OF CLAIMS 1-12, 19-29, 32, AND 34-37 IS OBVIOUS UNDER 35 U.S.C. §103(a) OVER MARSTERS ET AL. IN VIEW OF FRENCH PATENT FR 1,437,341.

The rejection of the claims over the combination of Marsters et al. and the French Patent is not supportable because the combination of Marsters et al. and the French Patent is not proper for multiple reasons.

Marsters et al. discloses a disposable insert 4 to be received within a supporting glass or cup 1 having a protecting portion 5, 6 which overlies the rim of the glass 1 to prevent a user's mouth from contacting the rim of the glass 1, thereby eliminating the need for cleaning of the glass 1 after each use.

The French Patent discloses a drinking container 1 comprising a cover 9 with a drinking spout 12 and an intervening baffle closure 5 having several apertures. The baffle closure 5 has a portion 6 that is inserted into the drinking container 1. The cover 9 has a portion 10 that is inserted into the top of the baffle closure 5. The apertures in the baffle closure 5 retard the flow of liquid from the drinking container and into the cover 9 to prevent liquid from rapidly flowing out of the drinking container 1 and through the spout 12 when the drinking container is tipped for drinking. The French Patent drinking container is akin to a child's sippy cup with a baffle for slowing the flow of liquid through the spout. Alternatively, the drinking container 1 can be used without the baffle closure 5 by installing the cover 9 directly onto the drinking container 1.

Initially, both Marsters et al. and the French Patent are non-analogous art. Marsters et al. is not within the field of endeavor of Applicants' invention. Marsters et al. is directed to a disposable insert which enables a glass to be repeatedly used by different users without the need to clean the glass after each use. Marsters et al. is totally unrelated to a confection cup assembly or to solving the problem of providing a supporting enclosure for a confection cup having a viscous liquid confection prepared therein.

Application No: 9/681,099
Page 9 of 27

Attorney Docket: 70254-328

The French Patent is also not within the field of Appellants' invention. The French Patent is directed to spill-proof or spill-resistant drinking containers and is not a confection cup assembly or any part of a confection cup assembly. The French Patent is not directed to solving the same problem as Appellants' invention, i.e. the retardation of the tendency of the cup to rotate in a sleeve when mixing a confection. The problem solved by the French Patent is that of spilling of the contents from a drinking container.

Second, assuming, *arguendo*, that the Marsters et al. Patent and the French Patent are analogous art, there is no teaching, motivation, or suggestion to combine the references as asserted by the Examiner. While Marsters et al. does disclose a cup support, the French Patent does not disclose any type of structure like the claimed collar as asserted by the Examiner. The French Patent only discloses a drinking container with a baffle and lid. The French Patent does not disclose a sleeve for supporting the cup 1 of the French patent. Nor is the baffle 5 of the French patent the claimed collar as asserted by the Examiner. Neither the baffle nor lid of the French patent serve to hold a cup in a sleeve (there is no sleeve in the French Patent), instead they serve to close the end of a cup. Therefore, there is no teaching or suggestion in either reference to make the combination as asserted by the Examiner.

Third, the Examiner's asserted teaching and suggestion for making the combination is not supported by either reference. The Examiner asserts, "FR '341, as seen in the Figs 1 and 2, teaches a collar for a cup. It would have been obvious to employ the collar of FR '341 in the cup of Marsters et al so that the cup could be used by infants." (July 3, 2002, Office Action, ¶11.) This is pure conjecture and speculation and not supported expressly or inherently by either reference as required by law. The Examiner's failure to show support in either reference for the combination fails to establish a *prima facie* case of obviousness.

To make the combination, the Examiner had to improperly characterize the cup of the French Patent as the claimed sleeve. In doing so, the Examiner completely ignores the express structure of the French Patent, which shows a closed cup. The Examiner appears to have selected the Marsters et al. patent for its basic teaching of a disposable cup supported by a holder and then went looking for a reference that showed a collar received within the cup. The Examiner appears to have picked the French Patent because of the structural similarity of the

Application No: 9/681,099
Page 10 of 27

Attorney Docket: 70254-328

baffle to the claimed collar. In doing so the Examiner ignores the clear showing in the drawings of the French Patent that there is no sleeve and he then asserts that it would be obvious to use the baffle for a collar, even though the baffle abuts the cup in the French patent. The Examiner's actions in forming the combination are a textbook example of hindsight reconstruction, which is impermissible. Therefore, the combination is improper and the rejection of claims 1-12, 19-29, 32, and 34-37 is unsupportable.

Assuming, however, for purposes of argument, that the combination could be made, it would, at best, teach only a disposable insert and glass (Marsters et al.) closed by either a baffle closure with apertures or a cover and spout (French Patent). Either of these combinations necessarily closes the top of the Marsters et al. glass since both the baffle closure and the cover are closing elements and not a collar as claimed. In other words, the alleged combination only teaches adding a closing lid to the Marsters et al. insert and glass.

The combination does not reach the claims as asserted by the Examiner. Claim 1 calls for a confection cup assembly comprising a collar having an insert portion to be inserted into the open top of a cup, and a sleeve for receiving the cup, wherein a portion of the sleeve overlaps a portion of the collar insert portion to compress the cup between the sleeve and the insert portion. The claimed collar requires that a mixer or the like be received therethrough to permit the mixing of the ingredients. There would be no way in which to mix the confection ingredients through the closed top of the combination. Therefore, the alleged combination does not have the collar as claimed since the interior of the container cannot be accessed through the alleged combination and claim 1 is patentable over the alleged combination.

Claims 2-12 depend from claim 1 and are patentable over the claimed combination for the same reasons as stated for claim 1.

Claim 9 is independently patentable over the alleged combination. Claim 9 depends from claim 1 and further calls for a friction enhancer provided on at least one of the collar and sleeve. The alleged combination does not disclose such a structure. The friction enhancer functions to improve the ability of the sleeve and collar to prevent the cup from rotating, which is easily caused by the mixer rotating the confection ingredients. If the cup rotates with the mixer, the confection ingredients will not be mixed properly.

Application No: 9/681,099
Page 11 of 27

Attorney Docket: 70254-328

Claims 10-12 depend directly or indirectly from claim 9 and are patentable over the alleged combination for the same reasons as claim 9.

Claim 11 is independently patentable over the alleged combination by calling for the friction enhancer of claim 9 to be located on the overlap portion of the collar. Given that the overlap portion functions to compress the cup therebetween, locating the friction enhancer in the overlap portion will further enhance the compression, which will also increase the static coefficient of friction to improve the performance of the friction enhancer.

Claim 12 depends from claim 11 and is patentable over the alleged combination for the same reasons as claim 11.

Independent claim 19 is independently patentable over the alleged combination. Claim 19 calls for a sleeve and collar as does claim 1. Claim 19 differs from claim 1 in that it defines the size of the sleeve relative to a cup and does not call for an overlapping portion between the collar and sleeve. Claim 19, like claim 1, is patentable over the alleged combination in that claim 19 calls for a collar and the combination does not disclose the claimed collar. The combination discloses a closed top regardless of how the references are combined. The collar by definition does not have a closed top and permits the insertion of a mixer into the sleeve to mix the ingredients of the confection.

Claims 20-29 depend from claim 19 and are patentable over the alleged combination for the same reasons as claim 19.

Claim 26 is independently patentable over the alleged combination. Claim 26 depends from claim 19 and further calls for a friction enhancer provided on at least one of the collar and sleeve. The alleged combination does not disclose such a structure. The friction enhancer functions to improve the ability of the sleeve and collar to prevent the cup from rotation, which is easily caused by the mixer rotating the confection ingredients. If the cup rotates with the mixer, the confection ingredients will not be mixed properly.

It is clear from the specification that the friction enhancer is something other than the physical properties of the material comprises either the sleeve or collar. Examples of suitable friction enhancers are shown in the specification to be a protrusion or additional frictional material provided on one of the collar or sleeve. The frictional material enhances the frictional

Application No: 9/681,099
Page 12 of 27

Attorney Docket: 70254-328

resistance over what is inherent of the material of the collar or sleeve.

Claims 27-29 are patentable over the alleged combination for the same reasons as claim 26.

Claim 28 is independently patentable over the alleged combination by calling for the friction enhancer of claim 26 to be located on the overlap portion of the collar. Given that the overlap portion functions to compress the cup therebetween, locating the friction enhancer in the insert portion will further enhance the compression, which will also increase the static coefficient of friction to improve the performance of the friction enhancer.

Claim 29 is independently patentable over the alleged combination in that it further defines the frictional enhancer as frictional material. As previously described, the frictional material is additional structure that increases the frictional resistance of the collar or sleeve, as the case may be, over the inherent physical properties of the material forming the collar and sleeve. One example in the specification of a suitable frictional material is a strip of rubber mounted to either the collar or sleeve. The alleged combination does not show such a structure.

Claim 32 is independently patentable over the combination. Claim 32 is similar in scope to claim 1, except that claim 32 additionally calls for the cup to be part of the cup assembly. However, like claim 1, claim 32 calls for a collar, which is not disclosed by the alleged combination. As such, claim 32 is patentable over the alleged combination.

Claims 34-37 depend directly or indirectly from claim 32 and are patentable over the alleged combination for the same reasons as claim 32.

Claim 34 is independently patentable over the alleged combination. Claim 34 depends from claim 32 and further calls for a friction enhancer provided on at least one of the collar and sleeve. The alleged combination does not disclose such a structure. The friction enhancer functions to improve the ability of the sleeve and collar to prevent the cup from rotation, which is easily caused by the mixer rotating the confection ingredients. If the cup rotates with the mixer, the confection ingredients will not be mixed properly.

Claim 35 is patentable over the alleged combination for the same reasons as claim 34.

Claim 36 is independently patentable over the alleged combination by calling for the friction enhancer of claim 34 to be located on the overlap portion of the collar. Given that the

Application No: 9/681,099
Page 13 of 27

Attorney Docket: 70254-328

overlap portion functions to compress the cup therebetween, locating the friction enhancer in the insert portion will further enhance the compression, which will also increase the static coefficient of friction to improve the performance of the friction enhancer.

Claim 37 is independently patentable over the alleged combination because there is no disclosure in the combination of a frictional material provided on one of the collar or sleeve as called for by claim 37. The alleged combination discloses no structure applied to the collar or sleeve to enhance the friction therebetween, let alone the claimed frictional material. The frictional material enhances the friction between the collar and the sleeve to reduce the likelihood that they will rotated relative to each other.

2. WHETHER THE INVENTION OF CLAIMS 14-16, 30, AND 38 IS OBVIOUS UNDER 35 U.S.C. §103(a) OVER MARSTERS ET AL. IN VIEW OF FRENCH PATENT FR 1,437,341 AND FURTHER IN VIEW OF SMITH ET AL.

The rejection of claims 14-16, 30 and 38 over the combination of Marsters et al, the French Patent, and Smith et al. is not proper because the combination is improper for multiple reasons.

Smith et al. discloses a funnel-like device having a neck 24 that is inserted into the neck of a bottle so that drinking from the bottle can be done in a manner similar to drinking from a glass. A seal or gasket 26 on the neck 24 seals the device into the bottle neck to eliminate leaking between the neck 24 and the bottle neck when a user drinks from the bottle.

First, the combination of Marsters et al, the French Patent, and Smith et al. is not proper in that it is based on adding Smith et al. to an already improper combination of Marsters et al. and the French Patent. The reasons for the impropriety of the combination of Marsters et al. and the French Patent are described above and apply equally as well here.

Second, the addition of Smith et al. to the combination of Marsters et al. and the French Patent cannot be sustained for reasons of its own. The Smith patent, like the Marsters et al. and the French Patent, is non-analogous art. Smith et al. discloses nothing more than a drinking aid to enlarge the drink opening of a bottle and is in no way within the field of Appellants' invention of a confection cup assembly. Nor is Smith et al. concerned with solving

Application No: 9/681,099
Page 14 of 27

Attorney Docket: 70254-328

the problem of preventing a cup from rotating relative to a sleeve. Smith et al. addresses the problem of drinking from a bottle rather than from a glass.

Also, there is no teaching, motivation or suggestion to combine Smith et al. with the combination of Marsters et al. and the French Patent. The Examiner has cited to no teaching or suggestion in any of the three references that would support the combination. The Examiner's addition of Smith et al. to the combination appears to be based solely on the desire to find some type of friction enhancer rather than any teaching, motivation, or suggestion in the references themselves. Once again, the Examiner's asserted combination constitutes nothing more than classic impermissible hindsight reconstruction.

Assuming, for purposes of argument, that the alleged combination could be made, it would only constitute the gasket or rib of Smith et al. circumscribing the baffle cover 5 or the cover 9 of the French Patent attached to a glass having a disposable insert as disclosed in Marsters et al. Such a combination does not reach the claimed invention of claims 14-16, 30, and 38 and the Examiner has failed to provide a *prima facie* case of obviousness as to these claims.

Claims 14-16 all depend indirectly from claim 1, and therefore require a collar. As previously stated, the Marsters et al. and French Patent combination did not disclose such a collar and the addition of Smith does not remedy the shortcomings of the prior combination. Therefore, claims 14-16 are patentable over the combination of Marsters, the French Patent, and Smith for the same reasons that claim 1 is patentable over Marsters and the French Patent.

Claim 14 is further patentable over the alleged combination in that claim 14 depends from claim 11 which calls for the friction enhancer of claim 9 to be located on the overlap portion of the collar, which is not disclosed by the alleged combination. Locating the friction enhancer in the overlap portion will further enhance the compression, which will also increase the static coefficient of friction to improve the performance of the friction enhancer. Since claims 15 and 16 depend from claim 14 they are also further patentable over the alleged combination.

Claim 30 depends from claim 19, and requires a collar as does claim 14. Since the alleged combination does not disclose the required collar, claim 30 is likewise patentable over

Application No: 9/681,099
Page 15 of 27

Attorney Docket: 70254-328

the alleged combination.

Claim 38 depends from claim 32, and requires a collar as do claims 14 and 30. Since the alleged combination does not disclose the required collar, claim 38 is likewise patentable over the alleged combination.

3. WHETHER THE INVENTION OF CLAIMS 17 AND 30 IS OBVIOUS UNDER 35 U.S.C. §103(a) OVER MARSTERS ET AL. IN VIEW OF FRENCH PATENT FR 1,437,341 AND SMITH ET AL. AND FURTHER IN VIEW OF FITZGERALD ET AL.

The rejection of claims 17 and 30 over the combination of Marsters et al, the French Patent, and Smith et al. and further in view of Fitzgerald et al. is not proper because the combination is improper for multiple reasons.

First, the combination of the four patents is not proper in that it is based on adding Fitzgerald to two already improper combinations of Marsters et al. and the French Patent, and the addition of Smith et al. The reasons for the impropriety of these two prior combinations are described above and apply equally as well here.

Second, the addition of Fitzgerald to the prior combination of Marsters et al. in view of the French Patent and Smith et al. cannot be sustained for reasons of its own. Fitzgerald et al., like the other three patents in the combination, is non-analogous art. Fitzgerald et al. discloses an insulated bottle holder having a bottle cap remover molded into the bottom wall, and is not within the same field of endeavor as Appellants' invention. Nor is Fitzgerald et al. directed to the same problem as the claimed invention. Fitzgerald et al. is directed to the problem of insulating a bottle and removing a bottle cap from the bottle. It is not directed to the problem of the rotation of a cup in a sleeve.

Third, there is no teaching, motivation or suggestion in any of the four references to combine Fitzgerald et al. with the prior combination. The Examiner has provided no express teaching or suggestion in any of the four references. The addition of Fitzgerald et al. appears to be based solely on the need to find some type of longitudinal rib to reach the elements of claims 17 and 30 rather than any teaching, motivation, or suggestion in the references themselves. The Examiner's asserted combination constitutes nothing more than

Application No: 9/681,099
Page 16 of 27

Attorney Docket: 70254-328

impermissible hindsight reconstruction.

Assuming, for purposes of argument, that the alleged combination could be made, it would only constitute the rib of Fitzgerald et al. extending along the body of the Marsters et al. patent, whose open top is closed by the baffle cover 5 or the cover 9 of the French Patent. Such a combination does not reach the invention of claims 17 and 30, and the Examiner has failed to provide a *prima facie* case of obviousness as to these claims.

Claim 17 depends from claim 1, and therefore requires a collar. As previously stated, the Marsters et al., French Patent, and Smith et al. patent combination did not disclose such a collar and the addition of Fitzgerald does not remedy the shortcomings of the prior combination.

Claim 30 depends from claim 19, and requires a collar as does claim 17. Since the alleged combination does not disclose the required collar, claim 30 is likewise patentable over the alleged combination.

4. WHETHER THE INVENTION OF CLAIMS 1-7, 9-13, 19-24, 26-29, 32, AND 34-37 IS OBVIOUS UNDER 35 U.S.C. §103(a) OVER MARSTERS ET AL. IN VIEW OF SCHMIEDEKNECHT (THE BRITISH PATENT).

The rejection of claims 1-7, 9-13, 19-24, 26-29, 32, and 34-37 over the combination of Marsters et al. and the British Patent is not proper because the combination is improper for multiple reasons.

The British Patent discloses a removable glass sanitary ring B for a drinking vessel A which keeps the consumer's mouth from contacting the drinking vessel A and which is removed for cleaning after the drinking vessel A has been used, thereby minimizing the unacceptable consequences of inadequately cleaned drinking vessels.

As previously stated, the Marsters et al. patent is non-analogous art. The British Patent, like Marsters et al., is also non-analogous art. The British Patent is not in the same field of endeavor as the Appellants' invention. A sanitary drinking ring is not the same field of endeavor as a sleeve, collar, and cup used to make a confection. The British Patent is not relevant to solving the problem of the invention. The British Patent solves the problem of how

Application No: 9/681,099
Page 17 of 27

Attorney Docket: 70254-328

to make sure a glass is safe to drink from. It does not address the problem of how to prevent the rotation of a cup when making a confection. Since the patents of the combination are non-analogous art, the combination is improper and must fail. Without the combination, the rejection must also fail.

In addition to the Marsters et al. and British Patent being non-analogous art, there is no teaching, motivation, or suggestion to make the combination as asserted; that is, adding the sanitary ring of the British Patent to the Marsters et al. cup and support. While both the Marsters et al. and British Patent teach the sanitary use of a cup in public, that similarity does not lead to the combination as asserted. The Marsters et al. structure does not need the sanitary ring to achieve sanitary drinking as the Marsters et al. structure uses a disposable cup for sanitary drinking. The sanitary ring of British Patent is redundant and unnecessary for the Marsters et al. structure. Similarly, the British Patent does not need the Marsters et al. disposable cup for sanitary drinking as the British Patent uses a reusable sanitary ring. The Marsters et al. disposable cup is redundant and unnecessary for the British Patent structure. Stated another way, both the Marsters et al. and British Patent solve the same problem of sanitary drinking from a public cup using distinct structures. Combining them is redundant and unnecessary.

Moreover, that the Marsters et al. and British Patent structures are incompatible also weighs against the combination. The obvious way to combine the references would be to substitute the sanitary structure of one for the other. In doing so, the sanitary ring of the British Patent would replace the paper cup of Marsters et al., which would result in the sanitary ring being inserted within the Marsters et al. support that cannot hold liquid because of the holes in the bottom. The resulting structure from the combination is non-functional. Alternatively, the sanitary ring could be added to just the paper cup; however, that combination teaches no more than Marsters et al.

In combining the disposable cup of Marsters et al. with the British cup, the paper cup of Marsters would replace the sanitary ring, with the British cup supporting the Marsters et al. paper cup. The resulting combination would teach no more than Marsters et al. without the holes in the bottom of the support, which is antithetical to the express teaching of Marsters et

Application No: 9/681,099
Page 18 of 27

Attorney Docket: 70254-328

al. (Col. 1, lines 35-40).

The Examiner has offered no express teaching or suggestion in either of the references to make the alleged combination to yield the structure of adding the sanitary ring to the support and disposable cup as described in the office action. The Examiner's reason for combining the references is based on the sanitary public drinking surface of each reference, which is a purpose unrelated to Applicant's claimed invention. However, there is no reason to add a sanitary ring to the Marsters et al. structure because the cup insert already provides the hygienic drinking surface. Once again, it appears that the only basis for the Examiner's attempt to combine the extension ring of the British Patent with Marsters et al. is that of hindsight reconstruction driven by the necessity of including a collar-like structure in order to reach the invention claimed in claims 1-7, 9-13, 19-24, 26-29, 32, and 34-37.

The combination of Marsters et al. and the British Patent to Schmiedeknecht is based solely on improper hindsight reconstruction. The Examiner has failed to provide a *prima facie* case of obviousness. Therefore, the rejection of claims 1-7, 9-13, 19-24, 26-29, 32, and 34-37 is improper and the rejection must fail. Each of the claims 1-7, 9-13, 19-24, 26-29, 32, and 34-37 is independently patentable because the combination is improper.

Assuming, *arguendo*, that the combination could be made, it would not result in the insertion of the sanitary ring into the disposable cup mounted within the support as asserted by the Examiner. Instead, the combination would result in one of three possible configurations: 1) the sanitary ring inserted within the support having holes in the bottom wall, 2) the sanitary ring inserted within the disposable cup, without the support, and 3) the disposable cup mounted within the non-disposable cup. None of these three combinations reach any of claims 1-7, 9-13, 19-24, 26-29, 32, and 34-37.

Claim 32 expressly calls for a confection cup assembly that comprises at a base level a cup, a collar, and a sleeve, with the cup being supported by the sleeve and the collar inserted within the cup. Assuming for the sake of argument that the sanitary ring of the combination is the same as the claimed collar (which it is not), none of the configurations of the combination disclose the three major elements of the cup, collar, and sleeve. The first combination at best discloses a sleeve and collar without a cup. The second combination at best discloses a collar

Application No: 9/681,099
Page 19 of 27

Attorney Docket: 70254-328

with a cup. The third combination at best discloses a cup mounted in a sleeve. However, none of the combinations disclose the three claimed elements of claim 32. Thus, claim 32 is patentable over the combination.

Claim 2 is independently patentable over the alleged combination in that it calls for the sleeve and collar to have a complementary profiles. The sanitary ring appears to have a different draft or taper than either the support or disposable cup, which would eliminate the possibility of complementary profiles.

Claims 9, 26, and 34 are independently patentable over the alleged combination. These claims all call for a friction enhancer on at least one of the collar or sleeve. The Examiner asserts that the friction enhancer limitation is met by the inherent frictional resistance in the material of the either the sleeve and collar. However, as previously described, the term friction enhancer as used in the application increases the frictional resistance of either the collar or sleeve beyond its inherent frictional resistance. The plain meaning of the term friction enhancer is consistent with the usage in the application. The friction enhancer enhances the friction of the collar or sleeve on which it is located beyond the frictional resistance attributable to the material properties of the material forming the collar or sleeve. The frictional enhancer is an additional structure added on or integrated with the sleeve or collar, not the sleeve or collar itself. Examples of the frictional enhancer include protuberances from the surfaces and a strip of rubber. The combination does not teach or suggest such an additional structure for enhances the inherent frictional resistance.

Claims 10, 27, 35 and 37 all depend from one of claims 9, 26, and 34, and are patentable for the same reasons.

Claims 11, 28, and 36 all locate the friction enhancer on the overlap portion and are independently patentable over the alleged combination. Given that the overlap portion functions to compress the cup therebetween, locating the friction enhancer in the insert portion will further enhance the compression, which will also increase the static coefficient of friction to improve the performance of the friction enhancer.

Claims 12 and 29 depend from claims 11 and 28, respectively, and are patentable over the alleged combination for the same reasons.

Application No: 9/681,099
Page 20 of 27

Attorney Docket: 70254-328

Claim 13 calls for the friction enhancer to be rubber, and is thus independently patentable over the alleged combination. The use of rubber further enhances the friction of the collar or sleeve on which it is located beyond their inherent frictional resistance.

5. WHETHER THE INVENTION OF CLAIMS 14-16, 30, AND 38 IS OBVIOUS UNDER 35 U.S.C. §103(a) OVER MARSTERS ET AL. IN VIEW OF SCHMIEDEKNECHT (THE BRITISH PATENT) AND FURTHER IN VIEW OF SMITH ET AL.

The rejection of claims 14-16, 30, and 38 over the combination of Marsters et al, the British Patent, and Smith et al. is not proper because the combination is improper for multiple reasons.

First, the combination of the three patents is not proper in that it is based on adding the Smith et al. patent to an already improper combination of Marsters et al. and the British Patent. The reasons for the impropriety of the prior combination are described above and apply equally as well here.

Second, the addition of Smith et al. to the prior combination of Marsters et al. in view of the British Patent cannot be sustained for reasons of its own. For the reasons previously stated all three patents are non-analogous art. The combination fails when any of the patents in the combination is non-analogous art.

Third, there is no teaching, motivation or suggestion to combine Smith et al. with the combination of Marsters et al. and the British Patent. The Examiner has cited to no express teaching in any of the references to make the alleged combination. Smith et al. discloses a funnel with an O-ring seal. There is no teaching or suggestion in Smith et al. to combine it with either Marsters et al. or the British Patent to provide either the cup support or sanitary ring with an O-ring seal. Neither Marsters et al. nor the British Patent are concerned with forming a seal. The Examiner's stated reason for making the combination ("It would have been obvious to employ the rib of Smith et al in the modified container of Marsters et al to provide a liquid tight seal as taught by Smith et al.") (July 3, 2002, Office Action, ¶15), is a manufactured reason for the sole purpose of having some basis for adding Smith et al. to the combination. The Examiner's addition of Smith et al. to the combination appears to be based solely on the

Application No: 9/681,099
Page 21 of 27

Attorney Docket: 70254-328

desire to find some type of friction enhancer rather than any teaching, motivation, or suggestion in the references themselves. Once again, the Examiner's asserted combination constitutes nothing more than classic impermissible hindsight reconstruction. Therefore, the combination is not supportable by the prior art references and must fail, bringing down with it the rejection of claims 14-16, 30, and 38.

6. WHETHER THE INVENTION OF CLAIMS 17 AND 30 IS OBVIOUS UNDER 35 U.S.C. §103(a) OVER MARSTERS ET AL. IN VIEW OF SCHMIEDKNECHT AND SMITH ET AL. AND FURTHER IN VIEW OF FITZGERALD ET AL.

The rejection of claims 17 and 30 over the combination of Marsters et al, the British Patent, and Smith et al. and further in view of Fitzgerald et al. is not proper because the combination is improper for multiple reasons.

First, the combination of the four patents is not proper in that it is based on adding Fitzgerald to two already improper combinations of Marsters et al. and the British Patent, and the addition of Smith et al. The reasons for the impropriety of these two prior combinations are described above and apply equally as well here.

Second, the addition of Fitzgerald to the prior combination of Marsters et al. in view of the British Patent and Smith et al. cannot be sustained for reasons of its own. Fitzgerald et al., like the other three patents in the combination, is non-analogous art for the reasons previously stated. Namely, Fitzgerald et al. discloses an insulated bottle holder having a bottle cap remover molded into the bottom wall, and is not within the same field of endeavor as Applicants' invention. Nor is Fitzgerald et al. directed to the same problem as the claimed invention. Fitzgerald et al. is directed to the problem of insulating a bottle and removing a bottle cap from the bottle. It is not directed to the problem of the rotation of a cup in a sleeve.

Third, there is no teaching, motivation or suggestion in any of the four references to combine Fitzgerald et al. to the prior combination. The Examiner has provided no express teaching or suggestion in any of the four references. The addition of Fitzgerald et al. appears to be based solely on the need to find some type of longitudinal rib to reach the elements of claims 17 and 30 rather than any teaching, motivation, or suggestion in the references

Application No: 9/681,099
Page 22 of 27

Attorney Docket: 70254-328

themselves. The Examiner's asserted combination constitutes nothing more than impermissible hindsight reconstruction.

CONCLUSION

In view of the foregoing, it is submitted that the continuing rejection of claims 1-17, 19-30, 32, and 34-38 is improper and should not be sustained. Therefore, a reversal of the rejections of December 23, 2003, is respectfully requested.

Respectfully submitted,

RICHARD E. VOGEL AND TIMOTHY J. FOLTZ

Dated: 11/1/04

By: Mark A. Davis

Mark A. Davis, Reg. No. 37,118
Michael F. Kelly, Reg. No. 50,859
MCGARRY BAIR PC
171 Monroe Avenue, NW, Suite 600
Grand Rapids, Michigan 49503
616-742-3500

G0145195